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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,151	12/26/2001	Johanna Fraki	442-010769-US(PAR)	8146
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PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER

3679

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,151

Applicant(s)

FRAKI ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9-12, 14-21, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Filler et al.), WO00/11827, in view of Yu et al., 6,684,087.

Regarding claim 1, Filler et al. disclose a method comprising:

identify a user of a computer (page 9, line 29) in a communication network (normally a computer is identified via an ethernet address, an user's ID or password in a service provider), the user enters the communication network using the computer (users are known to enter an internet through the computer); and

associate a digital collectible trading card with the user based on an identification received from the computer (page 2, lines 17-20; page 15, lines 28-32). However, the communication network is not a cellular mobile communication network and the computer is not a cellular mobile phone. Yu et al. disclose a computer being a mobile cellular phone to enter a cellular mobile communication network and use the internet to

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download digital collectible trading cards as an alternative to trading data over wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cellular mobile phone in a cellular mobile communication network to enter the internet, as an alternative to wired communication, and download digital collectible trading cards.

Regarding claim 2, Filler et al. teach the user trading the trading card with a second user (page 27, lines 12-15). The second user becomes associated with the trading card after the trade (pg. 27, lines 35-36).

Regarding claim 3, Filler et al., teach trading the trading card being performed under control of a server (pg. 27, line 15-34).

Regarding claim 5, Filler et al. teach the method further includes storing the trading card on a server and associating the trading card with the user being made at the server (pg 15, line 28 - pg. 16, line 5).

Regarding claim 6, Filler et al. teach associating indicates ownership of the trading card by the user.

Regarding claim 7, Filler et al. teach the method further includes notify the user of a given digital collectible trading card associated with a second user. The given collectible trading card is available for purchase or trade (pg. 27, line 20-22).

Regarding claim 9, Filler et al. teach the method further includes requesting to purchase the trading card before associating the trading card with the user (pg. 13, lines 30-31).

Regarding claim 10, Filler et al. teach entering an additional password at the mobile terminal (pg. 15, line 31-33). Applicant is reminded that a previous password has not been defined in claim 1 to render an additional password in claim 10.

Regarding claim 11, Filler et al., as modified above, teach the method further includes transmit a request from the cellular mobile phone to a server to send the trading card to the mobile phone; identify the user sending the request; compare the identity of the user with the user identification information associated with the trading card; and, provide the trading card to the user in response to matching the identity and the user identification information (pg. 15, lines 28 - pg. 16, line 5).

Regarding claim 12, Filler et al. teach providing the trading card to the user comprises transmit the trading card from the server to the mobile phone via the communication network; and, displaying the trading card on the mobile phone.

Regarding claims 14 and 25, Filler et al. teach the trading card includes at least one of a streamed video, an advertisement, digital music, a video clip (pg. 6, lines 9-15) and an avatar feature.

Regarding claims 15 and 26, Filler et al. teach the trading card includes at least one dynamic user-specific feature (pg. 2, lines 4-6).

Regarding claim 16, Filler et al. teach the trading card comprises data information (pg. 6, line 11), and the method further comprises updating data information of the trading card in real time based on a real event corresponding to contents of the trading card (col. 2, lines 6-11).

Regarding claim 17, Filler et al. teach updating data information of the trading card being done on request of the user (pg. 25, 2-8). Applicant is reminded that the information is accessible by a link upon being clicked by a user.

Regarding claim 18, the method further comprises adding an indicator including a certain price for the trading card (pg. 2, line 12-14).

Regarding claim 19, Filler et al., as modified above, teaches the communication network includes a cellular mobile communication network.

Regarding claim 20, the server stores digital collectible trading cards and association information identifying owners of the trading cards (pg. 9, line 3-4).

Regarding claim 21, Filler et al. disclose a digital collectible trading card system in a communication network comprising the communication network, at least one computer, and a server communicating with the computer via the communication network. However, the communication network is not a cellular mobile communication network or the computer is a mobile cellular phone. Yu et al. teach a mobile cellular phone in a cellular mobile communication network as an alternative setup to transfer data between devices in wireless connections versus wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile cellular phone in the cellular communication network as wireless connection instead of a wired connection.

Considering the modification, the phone is capable of displaying and controlling of at least one digital collectible trading card associated with a user of the mobile phone. The server is capable of storing the trading card and associating the user with the trading card. Associating is based on an identification of the user in the mobile network received from the phone.

Regarding claim 23, as modified above, Yu et al. teach the communication network including mobile network and internet. The mobile network is selected from a group consisting of GSM, GPRS, and UMTS.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 2 above, and further in view of Beuk et al., 5,774,673.

Regarding claim 4, Filler et al., as modified above, teaches trading the trading card with the second user includes storing the digital trading card at a first mobile terminal and transferring the trading card from the first mobile terminal to a second mobile terminal. However, trading is not transferred via a wireless communication. Beuk et al. teach in Figure 1 trading data between a first device and a second device via a wireless communication (infrared communication) to communicate and share files wirelessly. Therefore, as taught by Beuk et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transfer the digital trading cards between two cellular mobile phones via a wireless communication to trade the trading cards.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 11 above, and further in view of Peppel, 6,200,216.

Regarding claim 13, Filler et al., as modified above, fails to disclose providing the user with the digital collectible trading card comprises providing the trading card for view on the mobile terminal for a limited period of time only. Peppel teaches, on column 6, in lines 29-37, providing the trading card for view on the mobile terminal for a limited period of time only to generate scarcity of the trading cards. Therefore, as taught by Peppel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the trading card to the user for a limited period of time only to generate scarcity of the trading cards.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as respectively applied to claims 1 and 21 above, and further in view of Treyz et al., 6,587,835.

Regarding claim 8, applicant is reminded that cellular communication networks keep location information of the phones including the phone of the user in the network as taught by Filler et al. in the modification above. However, Filler et al., as modified above, fails to determine vicinity of a second user based on the location information of the mobile phone of the user and of the mobile phone of the second user. Treyz et al. teach determining vicinity of a second user based on location information of a mobile phone of a user and of a mobile phone of a second user to find proximity of the second user with respect to the user (col. 45, lines 21-30). Therefore, as taught by Treyz et al.,

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it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine vicinity of a second user based on the location information of the mobile phone of the user and of the mobile phone of the second user to find the proximity of the second user with respect to the user.

Regarding claim 24, given the method in claim 8 above, the cellular communication network requires a location register to locate the position of the cellular phone. Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a location register in the cellular communication network to determine vicinity information of a second cell phone user from a first cell phone user.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 21 above, and further in view of Atsmon et al., 6,607,136.

Regarding claim 22, Filler et al., as modified above, fails to disclose the system further including a digital physical trading card wirelessly communicating with the cellular phone. Atsmon et al., 6,607,136, teach in Figure 1 a system further including a digital physical trading card 10 wirelessly communicating with a device 14. However, the device as shown in Figure 1 is a computer instead of a cellular mobile phone. Atsmon et al. suggests that the device 14 can be a cellular phone to make a sale

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transaction without the need of a smart trading card reader (col. 2, lines 34-38).

Therefore, as taught by Atsmon et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the digital physical trading card wirelessly communicating with the cell phone in Yu et al. to make a sales transaction without the need of the smart trading card reader. Applicant is reminded that a computer, a PDA, a laptop computer, and a cellular phone are equivalent devices that function as a computer and the physical trading card is capable of presenting the digital collectible trading card transferred thereto independently of the cellular phone.

Response to Arguments

Applicant's arguments filed 8/03/04 have been fully considered but they are not persuasive.

Applicant has argued that the combination of Filler and Yu fails to disclose or suggest associating a digital collectible trading card with the user based on an identification of the user in the cellular mobile communication network received from the cellular mobile phone which is based on an identification of the user in the cellular mobile communicating network received from the cellular mobile phone.

Applicant further remarks that Filler, the primary reference, teaches the handling of digital collectible items but does not teach mobility, but rather a fixed data

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communication network. Applicant further remarked that the network is impossible to be used in real time. The examiner agrees that Fuller does not teach mobility, but disagrees in the issue of real time. All computers whether they are fixed or mobile are able to work in real time. When connected to an internet or intranet, computers or servers transfer live data or real streams to other computers or servers. Take for instance FTP, E-mail, Live Chat, or video conferencing, these programs work in real time. Therefore, fixed computers are fundamentally possible to be utilized in real time. Furthermore, there is nothing technically discussed as to why the fixed network would not work in real time or what will prevent the network from working in real time. Applicant instead remarks that the user can only connect to the system and utilize the system if the user happens to be located next to a fixed workstation. This analysis is out of scope as the user has nothing to do with the network's or computer's ability to work in real time. A user can just let the computer automate data in real time without the user's input.

Applicant further remarked that the application's invention is based on the use of portable terminals (namely cellular mobile phones). In response, the claims clearly state the applicant's invention and there is no doubt about the use of portable terminals in the claims of the application. The reference to Fuller et al. alone does not anticipate the claim but rather in view of Yu et al., thus the combined teachings teach transferring digital files (digital trading cards) in mobile or portable networks.

Furthermore, applicant further argued that in Filler et al. the system requires a user ID and password every time the user wants to use the fixed computer workstation. This argument is moot as Filler et al. teach in the abstract that each digital trading card is uniquely associated with the user (see lines 9-14 of the abstract). The use of mobile computers versus fixed computers is not a patentable step in performing the method. The same analogy goes for heating water. Whether the water is heated by using a gas stove, an electric stove, or microwave, the water is still heated. Since Filler doesn't use a mobile network, Yu et al. teaches the use of transferring digital files. Thus, the combination suggests trading digital collectible cards in a mobile network.

Applicant further argued that Yu never approaches the subject of handling digital collectible cards. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, applicant argued that Yu teaches the use of a user identifier for finding a certain user account and for generating certain instructions. Again, applicant has attacked the reference individually. Filler et al. is the reference that already teaches associating the card with the user. Yu is only used to teach the use of mobile phones to transfer digital files, which are synonymous to collectible digital trading cards.

Applicant has further argued that the synergy to applicant's invention relies on the association of the user with the digital trading card based on the identification of the user with the digital trading card in the cellular mobile communication network. In response, the examiner is very aware of this argument. However, Filler et al., as pointed above, teaches in the abstract, associating the trading card. Of course, it will be implied that associating the card is based on the identification of the user when the user enters the identification on the communication network. The fact that the communication network of Filler et al. is not a cellular mobile communication network is simplified by Yu et al. to teach trading digital cards in a cellular mobile network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a

general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

E.G.

October 27, 2004

Daniel P. Stodola

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